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Copyright
Matters

AF/ 2685
JW

April 25, 2005

Attn: Examiner Blane J. Jackson
Examiner Nguyen T. Vo
Edward Urban, Supervisor

Via Facsimile and First Class Mail
703-872-9306

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Application No. 10/038,939
Applicant: Robert M. Fitzgerald

Gentlemen:

Returned to you herewith is a Final Office Action, dated April 20, 2005, which we recently received for the above-referenced matter. John R. Ley is not the attorney for this matter. This document has been mailed to Mr. Ley in error.

It would be very much appreciated if the Patent Office would correct the correspondence address for this particular matter by deleting Mr. Ley's name and address.

Thank you for your prompt attention to this error.

Sincerely,

Connie Bursey
Legal Assistant
Connie@LeyIPLaw.com

Enclosure

cc: John R. Ley, Esq.



APR 27 2005

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,939	01/04/2002	Robert M. Fitzgerald	13965-043	8500

28785 7590 04/20/2005

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EXAMINER

JACKSON, BLANE J

ART UNIT PAPER NUMBER

2685

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

APR 25 2005

JOHN R. LEY, LLC



Office Action Summary

Application No.

10/038,939

Applicant(s)

FITZGERALD, ROBERT M.

Examiner

Blane J Jackson

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. The office recognizes the mistake that the USC 112 rejection for claim 1 should have been for claim 34 as suggested in the applicant's Remarks filed 26 October 2004. This USC 112 rejection for claim 34 and additionally for claim 62 is addressed below.

The applicant's other arguments have been fully considered but they are not persuasive. The office asserts that a prima facie case has been made where the primary art Mack teaches a headset with a hinged distal end and the secondary prior art teaches a headset with a pivoting distal end. It could be further argued that Mack's hinge is considered to pivot. The following rejection is essentially a repeat of the Non Final Rejection mailed 26 April 2004 but edited for clarity.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The phrase "less than about" in claim 34 is a relative phrase which renders the claim indefinite. This phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Reference MPEP 2173.05(b).

Claim 62, dependent on claims 61 to 37 recites the limitation "said base". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 24, 35-43, 55, 56, 61, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack, II et al. (U.S. Patent 5,991,637) with a view to Poon (U.S. Patent 6,252,970).

As to claims 1, 3-5, 37, 38, 42 and 43, Mack teaches a cordless telephone headset system and method of configuring a cordless telephone headset system for use comprising:

A headband having two distal ends (figures 1 and 2, column 3, lines 23-46 and column 4, line 61 to column 5, lines 15).

A telephone control connected to one of the distal ends of the headband (figure 8a, 11, column 8, lines 33-40),

A microphone pivotally connected to the telephone control (figure 8b, column 8, lines 41-49).

Mack also teaches a hinge (figure 11, (1102) or the like mounted above the telephone control to form part of a folding headband for storage purposes (column 9,

lines 23-31) but does not teach the telephone control is pivotally connected to one of the distal ends of the headband.

Poon teaches a headset for multimedia usage with a receiver (10) that includes a housing (12) containing an earpiece and a rotational connection to a boom microphone where the housing is attached to the head strap through a C-shaped body (30) that provides about a 180 degree vertical and horizontal rotation of the housing with respect to the head strap (figures 4 and 5, column 2, lines 33-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Mack with the housing rotation of Poon to achieve a better fit and to convert through operation of the swivel connection between a first and second use configurations.

As to claim 2, Mack teaches a cordless telephone headset system as described in claim 1 wherein the telephone control comprises a dial pad (figure 8a, (802), column 8, lines 33-37).

As to claim 6, Mack teaches a cordless telephone headset system as described in claim 2 further comprising an earpiece adjacent the one of the distal ends of the headband wherein the dial pad is transversely adjacent the earpiece (figure 8a and 8b, dial pad (802) opposite earpiece (202), and to identify the headset speakers or earpiece (202): column 3, lines 47-60).

As to claim 7, Mack teaches a cordless telephone headset system as described in claim 1 further comprising a microphone boom having two distal ends wherein the microphone is positioned adjacent one of the distal ends of the boom and wherein a second distal end of the microphone boom is pivotally connected to the phone control (figure 8b, column 8, lines 41-47).

As to claims 35, 36, 63 and 64, Mack teaches a cordless telephone headset method and system comprising:

A headband having two distal ends (figures 1 and 2, column 3, lines 23-46 and column 4, line 61 to column 5, lines 15).

A dial pad connected to one of the distal ends of the headband (figure 8a, 11, column 8, lines 33-40), the dial pad is configured to provide a hand-held configuration of the cordless telephone headset (figures 2, 5, 6 and 8a, column 6, lines 3-12).

Mack also teaches a hinge (figure 11, (1102) or the like mounted above the telephone control to form part of a folding headband for storage purposes (column 9, lines 17-31) but does not teach the telephone control is pivotally connected to one of the distal ends of the headband.

Poon teaches a headset for multimedia usage with a receiver (10) that includes a housing (12) containing an earpiece and a rotational connection to a boom microphone where the housing is attached to the head strap through a C-shaped body (30) that provides about a 180 degree vertical and horizontal rotation of the housing with respect to the head strap (figures 4 and 5, column 2, lines 33-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to exchange the hinge of Mack with the housing pivot of Poon to additionally provide a better user fit and to convert through operation of the swivel connection between a first and second use configurations.

As to claims 39-41, with respect to claim 37, Mack teaches a method of configuring a cordless telephone headset where the microphone may be pivotally rotated to the in-use or off hook condition (column 8, lines 41-49).

As to claims 24, 55 and 56, Mack teaches a method of configuring a cordless telephone headset system of aligning the telephone control with a headband of the cordless telephone headset system (figures 2, 8a) but does not teach adjustable rotating the telephone control to offset the telephone control with the headband.

Poon teaches a headset with a pivot member (figure 3, member (80) that allows the body to rotate through 180 degrees. It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize alternative offsets of the headset body of Mack in the manner of Poon to accommodate user earpiece fit or to reconfigure the assembly by rotating the headset body (and microphone boom) to fit the other ear.

As to claim 61, Mack teaches a method of configuring a cordless telephone headset system as described in claim 37 further comprising the step of providing

computer capability to the cordless telephone system (figure 5, controller (502), column 6, lines 3-12).

5. Claims 8-23, 25, 26 and 44-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack, II et al. (U.S. Patent 5,991,637) with a view to Poon (U.S. Patent 6,252,970) and further in view of Magnasco et al. (U.S. Patent 6,016,347).

As to claims 8 and 46, Mack modified does not teach a cordless telephone headset system as described in claim 7 further comprising a ratchet pivot providing pivotal connection between the microphone boom and the phone control.

Magnasco teaches a headset where a resilient pressing member is coupled to the housing and presses against the circular portion of the rotator element of the boom for increasing frictional resistance against rotation of the rotator element, shaft member and microphone boom (figures 1-3, column 4, lines 48-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate in the headset design of Mack the frictional resistance or like design of Magnasco to maintain the microphone boom in a desired position during use of the headset.

As to claims 9-15, 21, 44, 45 and 47-50, Poon of Mack *modified teaches the boom itself is bendable and its angle is adjustable through the rotation of the central part (16) of the receiver housing (12), figure 6, and is configured to accommodate both a user left ear configuration and a user right ear configuration, figures 2-6, column 3,*

lines 7-35. Poon does not specifically teach the microphone boom is adjusted with about 270 degrees or 360 degrees of rotation.

Magnasco teaches a headset with a boom microphone adjustable through 270 degrees of rotation to the phone control (figure 2). Magnasco further teaches several specific microphone boom positions through plus or minus 135 degrees from vertical to accommodate a left or right ear user and to trigger different modes of use (column 3, line 61 to column 4, line 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the microphone boom of Mack modified for wide rotational range adjustment as taught by Magnasco for the convenience of the user.

As to claims 16, 22, 50 and 53, Mack teaches a cordless telephone headset as described in claim 12 wherein the telephone control is configured to provide a hand held configuration of the cordless telephone headset system (figures 2, 5, 6 and 8a, hand held to read display and to use dial pad: column 6, lines 3-12).

As to claims 17, 18, 51 and 52, Mack teaches the microphone is rotated down to switch the wireless telephone to the in use or off hook condition (column 8, lines 41-49) but does not teach the microphone boom comprises a mute switch.

Magnasco teaches a headset where the rotated boom position signals the telephone control for standby mute or talk modes (figure 2, column 3, lines 25-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the microphone boom switch of Mack modified to include the additional telephone control modes of Magnasco for further convenience to the user of the telephone functions.

As to claims 19 and 20, Mack modified teaches a cordless telephone headset system as described in claim 2 further comprising a plurality of input elements positionally associated with the dial pad and configured to accommodate a plurality of user configurations (figure 5, 8a, operator control panel (504) for telephone or radio, column 6, lines 3-12).

As to claims 23 and 54, Mack teaches a cordless telephone headset system where the telephone control is pivotally configured to accommodate a user configuration within a corresponding telephone control rotation of zero to at least 90 degrees (reference the rejection for claim 1, specifically figure 8a of Mack depicts the headset with telephone control and Poon figure 4 teaches a pivot (80) to accommodate rotation of the headset body comprising earpiece and boom microphone).

As to claims 25 and 26, Mack teaches a portable wireless portable telephone/radio with control circuitry and an optional motorized antenna (figure 6) but does not specifically disclose a headset comprising a power source comprises a battery fixedly connected to the second distal end of the headband. However, it would have been

obvious to one of ordinary skill in the art at the time of the invention to necessarily include a battery in the system of Mack to source a portable radio type device.

6. Claims 27-32 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack, II et al. (U.S. Patent 5,991,637) and Poon (U.S. Patent 6,252,970) and further in view of Silver (U.S. Patent 4,882,745).

As to claims 27-30, 31, and 57-59, Mack modified teaches a headset and a method of configuring a cordless telephone headset to be used with a base station (Mack: column 3, lines 23-46) but do not teach a base station correspondingly configured to the headset.

Silver teaches a cordless headset telephone system comprising a base correspondingly configured with a receptacle corresponding to at least a portion of the telephone control and at least a portion of a second distal end of the headband, configured to a substantially upright orientation of the headband and the telephone control where the base comprises a footprint corresponding to the substantially upright orientation (figure 3, the headband shown cradled by the base station in an upright orientation, column 5, lines 6-27). Since Silver also teaches the cradle having charging contacts for the headset battery (column 1, lines 27-41), it would have been obvious to one of ordinary skill in the art at the time of the invention to identify in the base station of Mack the headset cradle of Silver so as to make the headset available to the user in a convenient manner and to provide positive positioning of the headset for connection and charging of the headset battery.

As to claim 32, Mack teaches a cordless telephone headset system further comprising telephonic control circuitry responsive to the telephone control and the base, where the telephone control comprises at least a portion of the telephonic control circuitry (figure 5, the headset of the headset/base station pair includes a control panel (504) and controller (502), column 6, lines 3-12).

As to claim 60, Mack does not teach a method of configuring a cordless telephone headset system comprising the step of charging a power source positioned adjacent a second distal end of the headband.

Silver teaches the headset has two headset disposed battery charging contacts connected to the base when the headset is at rest on the headset cradle (column 4, lines 1-15). Even though Silver does not specify the specific location of the charging contacts, it would have been obvious to one of ordinary skill at the time of the invention to modify Mack modified with the charging contacts of Silver placed where the headset comes in contact with the base in the storage position.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mack, II et al. (U.S. Patent 5,991,637), Poon (U.S. Patent 6,252,970) and Silver (U.S. Patent 4,882,745) and further in view of Babitch et al. (U.S. Patent 5,930,719).

As to claim 33 with respect to claim 27, Mack modified teaches a headset system but does not teach the base is configured for computer compatibility.

Babitch teaches a cordless handset system where the base station includes a connection to the wireless handset, telephone network and modem communication with a desktop computer (figure 1, column 2, line 65 to column 3, line 30). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the headset telephone system of Mack modified with the advantages of a computer connection as taught by Babitch for the functionality of a diction system from headset to the desktop computer or the functionality of an audio e-mail center.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J. Jackson whose telephone number is 571 272-

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7890. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached 571 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJJ

Nguyen Vo
4-17-2005

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PRIMARY EXAMINER